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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/276,455	03/25/99	FERSHT	A 674508-2001

HM12/1025  
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**EXAMINER**  
SHUKLA, R

ART UNIT	PAPER NUMBER
1632	6

**DATE MAILED:** 10/25/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/276,455

Applicant(s)

Fersht et al

Examiner

Ram Shukla

Group Art Unit

1632

☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-50 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-50 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1632

#### DETAILED ACTION

1. Claims 1-50 are pending in the instant application.

#### *Election/Restriction*

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-21, 29-31, 34-43, 47, drawn to polypeptides and uses thereof, classified in class 514, subclass 2.
  - II. Claims 22-28, 32-33, and 50, drawn to polynucleotides and uses thereof, classified in class 514, subclass 44.
  - III. Claims 44-46 and 48-49, drawn to antibodies and uses thereof, classified in class 424, subclass 184.1.

3. The inventions are distinct, each from the other because of the following reasons:

The inventions of the groups I, II, and III are drawn to nucleic acids, proteins and antibodies respectively, that are different compositions and therefore, are patentably distinct because they have materially different physical and chemical properties, structures, and utilities. For example, the invention of group I is drawn to a nucleic acids that would have different chemical and physical properties and functions compared to the inventions of the groups II and III that are drawn to proteins, and antibodies, respectively. Likewise the structure, function and utilities of a protein will be different from those of a nucleic acid or an antibody. Additionally, the utilities of the inventions of the groups I, II, and III will be different for each from the other, for example, an antibody can be used for the detection of a protein whereas a nucleic acid can be used for detecting the presence of mRNA or DNA in a sample. Furthermore, there is nothing on the record to indicate that these compositions are obvious variants. Therefore, the inventions of the groups I, III, and IV are patentably distinct each from the other and will require different search strategies, for example, in the non-patent literature.

4. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art shown by their different classification and their recognized divergent subject matter, and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Stanton, can be reached on (703) 308-2801. The fax phone number for this Group is (703) 308-8724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-0196.

Ram R. Shukla, Ph.D.

A handwritten signature in black ink, appearing to read "Bruce Campell", with a stylized, cursive script.

BRUCE R. CAMPELL  
PRIMARY EXAMINER  
GROUP 1800